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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,343	07/13/2007	Helena Nevalainen	36180-103011	8779
23644 7590 01/23/2009 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786			EXAMINER MOORE, WILLIAM W	
			ART UNIT 1656	PAPER NUMBER
			NOTIFICATION DATE 01/23/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

Office Action Summary	Application No.	Applicant(s)	
	10/573,343	NEVALAINEN ET AL.	
	Examiner	Art Unit	
	WILLIAM W. MOORE	1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. §§ 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claims 1-13, drawn to the special technical feature of an isolated mutant *Ophiostoma* strain or species having enhanced “excretion”, i.e., secretion of a protein, including a protease and a method of use thereof in an industrial process requiring secretion of the selected protease.

Group 2, claims 1-13, drawn to the special technical feature of an isolated mutant *Ophiostoma* strain or species having enhanced secretion of protein, including an amylase and a method of use thereof in an industrial process requiring secretion of the selected amylase.

Group 3, claims 1-13, drawn to the special technical feature of an isolated mutant *Ophiostoma* strain or species having enhanced secretion of a protein, including a lipase and a method of use thereof in an industrial process requiring secretion of the selected lipase.

Group 4, claims 1-13, drawn to the special technical feature of an isolated mutant *Ophiostoma* strain or species having enhanced secretion of a protein, including a glucoamylase and a method of use thereof in an industrial process requiring secretion of the selected glucoamylase.

Group 5, claims 1-13, drawn to the special technical feature of an isolated mutant *Ophiostoma* strain or species having enhanced secretion of a protein, including a β -galactosidase and a method of use thereof in an industrial process requiring secretion of the selected β -galactosidase.

Group 6, claims 1-13, drawn to the special technical feature of an isolated mutant *Ophiostoma* strain or species having enhanced secretion of a protein, including a β -glucosidase and a method of use thereof in an industrial process requiring secretion of the selected β -glucosidase.

Inventions of Groups 1, 2, 3, 4, 5, and 6 do not relate to a single general inventive concept, each to the other, under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: 1) No isolated mutant *Ophiostoma* strain or species is shown to have a same or corresponding special technical feature of producing a particular, selected, protein or enzyme, or a set of particular, selected,

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proteins or enzymes, where no mutant *Ophiostoma* strain or species produces an enzyme, or at least a pair of enzymes, having distinct activity and selected by a specific process and where no process of specifically selecting a specific, particular, enzyme activity is otherwise disclosed. 2) There is no same or corresponding special technical feature in the design of the different inventions where biolistic transformation – which is a random process – of *Ophiostoma* cells with a set of transcription-regulating polynucleotides affords no particular selection for the enhanced expression of a particular protein, or any particular enzyme recited by the claims. 3) There is no same or corresponding special technical feature in the mode of operation of the different inventions where no selection of either an endogenous enzyme-encoding gene loci, nor a transformation with (a) polynucleotide(s) encoding selected exogenous enzymes, is disclosed. Where each isolated mutant *Ophiostoma* strain or species is prepared by a random process to engender secretion of generic or sub-generic proteins, such as enzymes of different activities, each lacks a same or corresponding special technical feature of the other. 4) The technical feature of at least Groups 1-6, *i.e.*, an isolated mutant *Ophiostoma* strain having enhanced secretion of a protein, does not appear to be a contribution over the prior art. The technical feature of Groups 1-6 appears to be disclosed by the reference of Temple et al. (*Fungal Genetics and Biology* 22:39-53, 1997; cited as reference AB in the IDS filed on 7/13/07), which teaches a mutant strain of *Ophiostoma* with increased cerato-ulmin in culture filtrate as compared to its parent strain (p. p. 46, column 1) and thus the technical feature of Groups 1-6 is not a contribution over the prior art.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William W. Moore whose telephone number is 571.272.0933 and whose FAX number is 571.273.0933. The examiner can normally be reached Monday through Friday between 9:00AM and 5:30PM EST. If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's Supervisory Primary Examiner, Jon P. Weber, can be reached at 571.272.0925. The official FAX number for all communications for the organization where this application or proceeding is assigned is 571.273.8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571.272.1600.

/William W. Moore/
Examiner, Art Unit 1656